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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,680	01/23/2004	Andrew Halliday	1410/67626	7480

48940 7590 09/09/2008
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EXAMINER	
ALEXANDER, REGINALD	

ART UNIT	PAPER NUMBER
3742	

MAIL DATE	DELIVERY MODE
09/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/763,680	HALLIDAY ET AL.	
	Examiner	Art Unit	
	Reginald L. Alexander	3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-12,40-42 and 45-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *46-50* is/are allowed.

6)☒ Claim(s) *1,3-12,40-42 and 45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/763,534. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are an obvious variation of the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPO 0638486 in view of Fischbach et al.

There is disclosed in the European document a cartridge for use in a beverage preparation machine, the cartridge containing a beverage ingredient (such as chocolate or a liquid syrup for preparing a hot beverage) and being formed from substantially air and water impermeable materials (plastic), the cartridge including an inner member 18 and outer member 2, an inlet, an outlet and means for forming a jet of liquid, the inner and outer members being conjoined by a snap-fit arrangement, and wherein the inner member is contained entirely within the outer member.

Fischbach discloses that it is known in the art to provide a liquid ingredient (such as chocolate syrup or gel) within a capsule (cartridge) and provide hot water to the capsule for the formation of a hot beverage.

It would have been obvious to one skilled in the art to substitute the powdered chocolate ingredient or liquid syrup taught in EPO 0638486 with the liquid chocolate ingredient taught in Fischbach, in order to provide a form of ingredient which dissolves faster upon contact with hot water.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bentley in view of Fischbach.

There is disclosed in the Bentley a cartridge for use in a beverage preparation machine, the cartridge containing a beverage ingredient (such as chocolate or a liquid syrup for preparing a hot beverage) and being formed from substantially air and water impermeable materials (plastic), the cartridge including an inner member 37 and outer member 20, an inlet, an outlet and means for forming a jet of liquid, the inner and outer members being conjoined by, and wherein the inner member is contained entirely within the outer member.

Fischbach discloses that it is known in the art to provide a liquid ingredient (such as chocolate syrup or gel) within a capsule (cartridge) and provide hot water to the capsule for the formation of a hot beverage.

It would have been obvious to one skilled in the art to substitute the powdered chocolate ingredient or liquid syrup taught in Bentley with the liquid chocolate ingredient taught in Fischbach, in order to provide a form of ingredient which dissolves faster upon contact with hot water.

Claims 1, 3-12, 40 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Favre et al. '052 in view of Fischbach et al.

There is disclosed in Favre a cartridge for use in a beverage preparation machine, the cartridge formed by inner member 3 and outer member 15, the cartridge containing one or more ingredients 17, the cartridge having an inlet 5 for the introduction of a liquid into the cartridge and an outlet 22 for discharge of a beverage

and at least one inlet 24 for air and means 24 and tapered passageway at outlet 22 for generating a pressure reduction of a jet of beverage, whereby, in use, air from the air inlet is incorporated into the beverage, and wherein the inner member is contained entirely within the outer member in an extraction position and the outlet is fixed relative to the inlet when in the extraction position.

Fischbach discloses that it is known in the art to provide a liquid ingredient (such as chocolate syrup or gel) within a capsule (cartridge) and provide hot water to the capsule for the formation of a hot beverage.

It would have been obvious to one skilled in the art to substitute the powdered coffee ingredient of Favre with the liquid chocolate ingredient taught in Fischbach, in order to provide a form of ingredient which dissolves faster upon contact with hot water.

In regards to the percentage of solids and viscosity of the ingredients, such is an obvious matter of design choice to one skilled in the art, since the final taste of the beverage is determine by adjustments to such variables. One skilled in the art would provide the necessary adjustments to suit their taste and desires.

Allowable Subject Matter

Claims 46-50 are allowed.

Response to Arguments

Applicant's arguments with respect to claim 40 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 18 July 2008 have been fully considered but they are not persuasive. Applicant states that Favre reference fails to disclose an outlet fixed

relative to the inlet. It should be noted that the inlet on the inner member, when in an extraction position within the outer member, is fixed relative to the outlet on the outer member. The term "fixed" is a relative term and can defined differently based upon the structural situation presented.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reginald L. Alexander whose telephone number is 571-272-1395. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Reginald L. Alexander/
Primary Examiner
Art Unit 3742